

Appl. No. 09/963,873  
Reply to Office action of September 9, 2004

### Remarks

Claims 1-4 and 6-9 have been amended. Claims 5 and 10 have been cancelled. Reconsideration and favorable action in this application is respectfully requested.

### Claim Objections

Applicants have corrected claim 2, lines 9 and 10, so that the word "frame" has been replaced with the words "from a." Applicants inadvertently misspelled the word "from." In addition, line 17 has been deleted to correct the typographical error. With regard to claims 3 and 8, "a" has been replaced with "an" to correct the grammatical error.

### Claim Rejections - 35 U.S.C. §§ 102 & 103

The Examiner has rejected claims 1, 2, 5-7, and 10 as being anticipated by *Haim et al.* Applicants have amended independent claims 1, 2 and 7 to require that the trackable markers are "optically" trackable. The Examiner appears to be assuming that the fiducials and markers are the same. However, the functions and physical characteristics of the members are different. To make things more clear, the claims have been amended to place emphasis that the fiducials, which are intended to create distinctive, black circles on the fluoroscopic images, are embedded in a radio-transparent structure (i.e., one that does not block x-ray radiation). The optically trackable markers depend from the radio transparent structure so that they can be tracked using an optical tracking system.

*Haim* discloses only use of a magnetic marker that can be tracked, therefore does not anticipate any of the claims.

With regard to the Examiner's rejection of claims 3 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Haim* in view of *Cosman*, the Examiner states that *Cosman* discloses the "markers of the reflecting type, specifically one with an infrared light source." The Examiner therefore states: (1) "it is well known that LED's are often used light sources in applications requiring smaller dimensions", and (2) "it would be obvious to modify *Haim* in view of *Cosman* because as *Cosman* states 'the fiducial marks have individual shapes or other features, differing from another, so that each of the marks may be easily individually identified.'" Frankly, Applicants do not understand the reasoning of the Examiner. However the Examiner's reasoning is interpreted, it does not state a motivation found in the prior art for modifying *Haim et al.* to include an optically trackable marker in place of its magnetically trackable element. Applicants submit that dimensional limitations and shapes of the fiducial marks are irrelevant to any

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modification necessary to arrive at the claimed invention. Accordingly, Applicants submit that the Examiner has failed to establish any suggestion or motivation to combine the references. See MPEP § 2143 ("To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.").

Claims 3, 4, 6, 8 and 9, which depend from independent claims 1 and 7, further define the present invention; therefore, it is respectfully submitted that these dependent claims are also in condition for allowance.

#### Conclusion


Applicants respectfully request reconsideration and allowance of the application in view of the foregoing amendments and remarks. Please telephone the undersigned representative should he be of any assistance in connection with the reconsideration.

A Two-Month Petition for Extension of Time is attached (in duplicate).

Please charge deposit account no. 13-4900 of Munsch Hardt Kopf & Harr, P.C. any additional fees associated with this paper.

Respectfully submitted,

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